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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,316	08/20/2001	Stephen C Porter	29985/01-185	7064
4743	7590	06/03/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			SHARAREH, SHAHNAM J	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/933,316	PORTER, STEPHEN C
	Examiner	Art Unit
	Shahnam Sharareh	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 March 2005.
- 2a) This action is **FINAL**.                                   2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3-5,9-11 and 15-41 is/are pending in the application.
  - 4a) Of the above claim(s) 29-37 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 3-5, 9-11, 15-28, 38-41 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Submission filed on March 14, 2005 has been entered. Claims 1, 3-5, 9-11, 15-41 are pending. Claims 1, 3-5, 9-11, 15-28, 38-41 read on the elected species and are under consideration. Claims 29-37 are withdrawn from further consideration for the reasons set forth in Paper Nos. 3, 5-6.

The claims are directed to compositions comprising a non-cyanoacrylate polymers such as poly(vinyl esters) or poly(vinylethers) in combination with alkyl cyanoacrylate monomers and a radiopacifier .

2. Applicant's arguments filed March 14, 2005 have been fully considered but they are not persuasive for the reasoning discussed below.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3-5, 9-11, 15-28, 39-41 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Krall et al WO 00/44287 (WO '287) in view of Slaikeu et al US Patent 6,160,025.

4. Applicant argues that Slaikeu uses the hydrolyzed polyvinyl acetate polymers as an agglomerant not a rheology modifying agent. (see Arguments at page 8, 1<sup>st</sup> para).

5. In response Examiner states that the fact that applicant has recognized another advantage, which would, flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Here, Krall

merely lacks the non-cyanoacrylate polymers in his compositions. Slaikeu is used to show that non-cyanoacrylate polymeric moieties, such as polyvinyl acetate (PVA) having a molecular weight (MW) in the ranges of 10,000-500,000, are suitable polymers for use as embolizing agent (abstract; col 9, lines 19-35) and they can specifically provide suitable viscosities for polymeric embolizing agents (see col 5, lines 1-3). Thus, using such non-cyanoacrylate polymers with the polymers of Krall would have flown naturally from the teachings of the references regardless of their intended purpose.

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the both the references and the general knowledge in the art provide for such motivation.

First, Slaikeu specifically provides that viscosities of polymeric embolizing agents are sensitive to the MW of the polymer employed. (see col 5, lines 1-3). Accordingly, Slaikeu provides guidance that MW can be modified to provide optimal viscosity for embolizing agents (see col 5, lines 5-26).

Second, it is well recognized in the art that embolic agents for in vivo delivery require a suitable viscosity in order to reach the site of interest. Thus, the state of art

recognizes optimization of the viscosity of a polymeric composition by adding other suitable and compatible agents.

Further, it has been held to be *prima facie* obvious to combine two compositions each of which is taught by prior art to be useful for same purpose in order to form third composition that is to be used for very same purpose; idea of combining them flows logically from their having been individually taught in prior art. *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980). Here, there is no evidence showing that combination as proposed would not flow logically from the teachings of the cited references. There is no direct teaching away. Thus, the combination of references is proper.

7. Finally, in response to applicant's argument that polyvinyl acetate polymers in Slaikeu has a different intended purpose, Examiner replies that an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Here, no matter what the intended purpose of the polymers of Slaikeu, they do not have any structural difference with those instantly claimed. Thus, the fall polymers of Slaikeu falls within the scope of the instant claims and can inherently provide the same function.

8. Applicant also argues that the viscosity of various molecular polymers of partially hydrolyzed polyvinyl acetate is not relevant to the applicant's use rheology polymers above a molecular weight of 200,000. (see Remarks at page 8, 3<sup>rd</sup> para.). In response,

Examiner states that such line of arguments are not commensurate with the scope of the pending claims, because the instant claims are not limited to any such limitations.

9. Claims 1, 3-5, 9-11, 15-28, 38-41 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Krall et al WO 00/44287 (WO '287) in view of Slaikeu et al US Patent 6,160,025 as applied to claims 1, 3-5, 9-11, 15-28, 39-41 and further in view of Hechenberger et al US Patent 4,997,861.

10. With respect to this rejection Applicant argues that Hechenberger is used for industrial purposes. (see Arguments at page 9). In response to applicant's argument Examiner states that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, Hechenberger teaches methods of improving the adhesive properties and stability of compositions comprising cyanoacrylate and non cyanoacrylate polymeric in general, regardless of their intended use. Examiner views methods of improving the stability of polymeric compositions to be a function of the type of polymers employed in the composition regardless of their intended use. Here, Hechenberger solves the problem of associated with the stability of a polymeric compositions There is no evidence on record that improving the stability of compositions as described by Hechenberger is a function of specific intended use or specific type of application. Since, such problem is reasonable pertinent to the instant claims, Examiner

views Hechenberger to be applicable. Accordingly, the rejection is proper and is maintained.

***Conclusion***

No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

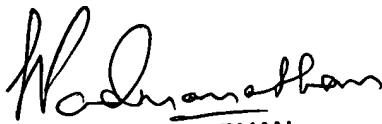
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 571-272-0630. The examiner can normally be reached on 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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